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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,692	01/22/2002	Bruno Macchia	50203/015001	8279

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KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
919 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

LEWIS, PATRICK T

ART UNIT	PAPER NUMBER
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*1623

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,692

Applicant(s)

MACCHIA ET AL.

Examiner

Patrick T. Lewis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z. 6) ☐ Other: .

DETAILED ACTION

Objections/Rejections Set For the in Office Action dated September 10, 2002

1. This application claimed benefit to international application No. PCT/EP00/07023 filed on July 21, 2000. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).
2. Claims 4-6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).
3. Claims 5-6 were rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).
4. Claims 1 and 4-6 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "saccharidic portions" in claim 1, line 9, has not been defined in such a way as to apprise the skilled artisan in the field of the metes and bounds of the claimed invention. In the absence of such definition, the term "saccharidic portions" is indefinite in all occurrences.

Claims 5-6 provide for the use of the compounds of general formula (I), but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Applicant's Response dated March 17, 2003

5. In the Response filed March 17, 2003, the specification and claims 4-6 were amended. Applicant presented arguments directed to the rejection of claims 1 and 4-6 under 35 U.S.C. 112, second paragraph. Claims 1-6 are pending. An action on the merits of claims 1-6 is contained herein below.

6. The amendment of claims 4-6 in the Response dated March 17, 2003 has rendered the objection as set forth in the Office Action dated September 10, 2002 moot.

7. The amendment of claims 5-6 in the Response dated March 17, 2003 has rendered the rejection of claims 5-6 under 35 U.S.C. 101 as set forth in the Office Action dated September 10, 2002 moot.

8. The rejection under 35 U.S.C § 112, second paragraph, is maintained for the reasons of record set forth in the Office Action dated September 10, 2002.

Response to Arguments

9. Applicant's arguments filed March 17, 2003 have been fully considered but they are not persuasive.

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Applicant argues that the term "saccharidic portions" is well known in the art and that it refers to a sub-class of carbohydrates. The examiner respectfully disagrees. The examiner acknowledges that the term "saccharidic" is known in the art; however, the term "saccharidic portion" renders claims 1 and 4-6 indefinite. There are a vast number of compounds that encompassed by the term "saccharide". It is unclear what "portion" of any one of the vast number of compounds encompassed by the term "saccharidic" applicant intends as a substituent as defined by variables R_1 and R_2 of the instantly claimed compounds of general formula (I). The term "portion" is seen to encompass everything from a single atom to a near complete molecule of any given saccharide. The lack of clarity does not allow one of ordinary skill in the art to ascertain the metes and bounds of the instantly claimed compounds.

Claim Objections

10. Claims 2-3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. Claims 1-6 are pending. Claims 1 and 4-6 are rejected. Claims 2-3 are objected to. No claims are allowed.

Contacts

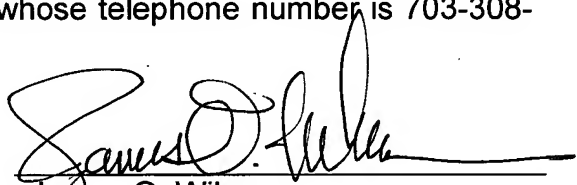
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 703-305-4043. The examiner can normally be reached on M-F 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Patrick T. Lewis, PhD
Examiner
Art Unit 1623

ptl
May 30, 2003



James O. Wilson
Supervisory Patent Examiner
Technology Center 1600